

**REMARKS**

The application has been amended in manner to place it in condition for allowance.

**Status of the Claims**

Claim 13 has been amended to include the further proviso that that  $R_1$  and  $R_4$  cannot be a fluorine atom when  $R_2$  or  $R_3$  is the hydroxyl group or the halogen atom. Support for the amendment may be found, for example, in original claim 13 and at page 11, line 255 to page 12, line 277. That is, originally disclosed formula 1 describes a finite number of alternative structures, and the new proviso language explicitly excludes those wherein  $R_1$  and  $R_4$  each is a fluorine atom when  $R_2$  or  $R_3$  is the hydroxyl group or the halogen atom. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977); *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984); M.P.E.P., Eighth Ed., Rev. 6 (September 2007) at § 2173.05(i).

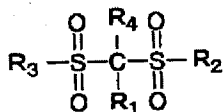
Claim 13 remains pending.

**Claim Rejections-35 USC §102**

Claim 13 was rejected under 35 U.S.C. § 102(b) as being anticipated by JULJI et al. JP 09-301981 A (JULJI), based on JPO Abstract and machine translation. This rejection is respectfully traversed for the reasons below.

JULJI was offered for teaching a methanetrissulfonic acid derivative, such as a compound represented by  $\text{HC}(\text{SO}_2\text{OCH}_2\text{CF}_3)_3$ .

In the presently claimed formula 1:



$\text{R}_1$  and  $\text{R}_4$  may be  $-\text{SO}_2\text{X}_1$ , wherein  $\text{X}_1$  is a substituted or unsubstituted alkyl group having 1 to 5 carbon atoms. However,  $\text{R}_1$  and  $\text{R}_4$  do not include  $-\text{SO}_2\text{OCH}_2\text{CF}_3$  of JULJI.

Therefore, JULJI fails to anticipate claim 13, and withdrawal of the rejection is respectfully requested.

Claim 13 was rejected under 35 U.S.C. § 102(e) as being anticipated by LIM et al. US 2004/0214091(LIM). This rejection is respectfully traversed for the reasons below.

LIM has a filing date of April 7, 2004.

The present application claims priority to JP 2003-416516, filed December 15, 2003. A verified English translation of this priority document is provided in the Appendix of this amendment. Thus, Applicant's claim to priority has been perfected.

Therefore, LIM fails to qualify as "prior art", and withdrawal of the rejection is respectfully requested.

Claim 13 was rejected under 35 U.S.C. § 102(e) as being anticipated by ADACHI et al. WO 2004/07202 (ADACHI), based on US 7,482,302 as the English language equivalent. This rejection is respectfully traversed for the reasons below.

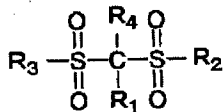
ADACHI was offered for teaching:

(1)  $R-S(=O)_n-CF_2-SO_3H$  (1), and

(3)  $R-S(=O)_n-CF_2-SO_2X$  (3).

R is identified as a group bound to an adjacent sulfur atom through a carbon atom, and examples of R being an optionally substituted alkyl group, an optionally substituted haloalkyl group, an optionally substituted alkenyl group, an optionally substituted haloalkenyl group, an optionally substituted alkynyl group, an optionally substituted haloalkynyl group, an optionally substituted cycloalkyl group, etc. Also, n is 1 or 2, and X is a halogen atom.

However, the presently claimed formula I:



R<sub>1</sub> and R<sub>4</sub> cannot be a fluorine atom when R<sub>2</sub> or R<sub>3</sub> is either a hydroxyl group (e.g., in formula (1) of ADACHI) or a halogen atom (e.g., in formula (3) of ADACHI). Thus, ADACHI is excluded by the claimed invention.

Therefore, ADACHI does not anticipate claim 13, and

withdrawal of the rejection is respectfully requested.

### **Double Patenting Rejection**

Claim 13 was provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1 and 12 of copending US Application No. 10/582,855.

Since the rejection is provisional, it is, again, respectfully requested that the rejection is held in abeyance until allowance of the instant application or the copending application, in accordance with US practice.

### **Conclusion**

In view of the amendment to the claims, the perfecting of Applicant's claim to priority and the foregoing remarks, this application is in condition for allowance at the time of the next Official Action. Allowance and passage to issue on that basis is respectfully requested.

Should there be any matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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**APPENDIX:**

The Appendix includes the following item(s):

- a verified English translation of foreign priority document